REMARKS

Reconsideration of the above application is respectfully requested.

Claims 1-14 are pending.

Claim 2 has been cancelled.

Claims 15-17 have been cancelled.

Claims 1 and 3-14 have been amended.

Claim 1 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Yan et al. and Rabinkin et al.

Claims 1, 3, 5 and 8 to 14 stand rejected under 35 U.S.C. § 103(a) unpatentable over each of Rabinkin et al. or Sloboda et al.

Further, claims 1 and 3-14 have been amended to improve their form, but without adding new subject matter.

All pending claims are now in good order for allowance, and such is respectfully requested.

I. REJECTIONS UNDER 35 U.S.C. § 112, second paragraph

Claims 1 and 2-14 have been amended to make them definite and to particularly point out the subject matter that Applicant regards as the invention.

The amended claims do not add new subject and all changes are fully supported in the application as filed.

Moreover, the terms "silicon/copper" and "boron/copper" are understood by one skilled in the art to mean a compound consisting of silicon incorporated in

copper and boron incorporated in copper. The amounts of silicon to copper and boron to copper are defined on page 14, paragraph 0066, of the application as filed. For example, silicon/boron is 10% silicon in copper and boron/copper is 2% boron in copper.

Therefore, the claims 2 and 3-14 are now in good order for allowance and such is respectfully requested.

II. REJECTIONS UNDER 35 U.S.C. § 102(e)

The claimed invention relates generally to white gold compositions not containing either nickel or palladium, which are elements common to other white gold compositions. In preparing white gold compositions, a certain percentage of the pure gold (i.e. 10K, 14K, 18K, 22K and 24K) is blended or mixed with a certain percentage of the pre-mixed alloy. For example, in a 10K white gold composition is comprised of about 41.67% pure gold and 59.33% of the non-nickel, non-palladium alloy composition (Example 2, p. 14; claims 1 and 2-14). In the claimed invention, the pre-mixed alloy composition is comprised of copper, silver, and zinc and manganese and trace amounts of tin, cobalt, silicon/copper and boron/copper.

A. The Prior Art

1. U.S. Patent No. 6,413,651 to Yan et al. (Yan '651)

Yan '651 teaches an alloy only. The alloy consists essentially of nickel, zinc, silicon, tin, manganese, phosphorus, silver, carbon, iron and copper.

Yan '651 does not teach white gold compositions, which comprise, in part, an alloy composition further comprised of copper, silver, zinc and manganese and trace amounts of tin, cobalt, silicon/copper and boron/copper. Further, Yan '651 alloys are comprised of 4-13% by weight nickel (claims 1 and 4; column 5,

line 67; column 6, lines 3, 63; column 7, line 28; Table 1 and 2). In contrast, the claimed invention recites white gold compositions, further comprised of an alloy composition that does not contain nickel.

2. U.S. Patent No. 4,587,097 to Rabinkin et al. (Rabinkin '097)

Rabinkin '097 teaches an alloy only. The alloy consists essentially of manganese, silicon, tin, zinc, silver, indium and copper.

Rabinkin '097 does not teach white gold compositions, which comprise, in part, an alloy comprising of copper, silver, zinc and manganese and trace amounts of cobalt, silicon/copper and boron/copper.

3. U.S. Patent No. 4,049,434 to Sloboda et al. (Sloboda '434)

Sloboda '434 teaches an alloy only. The alloy consists essentially of zinc, silver, manganese, nickel and copper.

Sloboda '434 does not teach white gold compositions, which comprise, in part, an alloy composition further comprised of copper, silver, zinc and manganese and trace amounts of tin, cobalt, silicon/copper and boron/copper. Further Sloboda '434 teaches an alloy comprising of 0.2-10 wt. nickel (Abstract; claim 1; column 1, lines 36, 47; column 2, lines 38, 40; column 4, line 5; Table 1). In contrast, the claimed invention recites white gold compositions, further comprised of an alloy composition that does not contain nickel.

B. **The claimed invention is not anticipated by the prior art**

Claims 1 and 3-14 have been amended. As amended, the claimed invention is not anticipated by the cited references because the cited references teach only an alloy and not a white gold composition which is comprised, in part,

of an alloy composition. That is, the claimed invention is a white gold composition used to cast, fabricate or solder jewelry whereby the alloy is first made and then later blended with a certain percentage of 24K, or pure, gold.

Firstly, the cited references teach a metal alloy not a gold composition, which is comprised, in part, of an alloy. Typically gold jewelry does not consist of pure gold or 24K gold, rather it consists of a certain percentage of 24K gold (i.e., 10K, 14K or 18K gold). The karat of gold indicates the "unit of fineness for gold equal to 1/24 part of pure gold in an alloy." The Webster's Ninth Collegiate Dictionary, Merriam-Webster Inc. (1991). For example, a 10K gold composition is comprised of 41.67% 24K gold (or pure gold) and the balance is comprised of an alloy. In the claimed invention, the alloy compositions are made first before blending the alloy with the gold. The claimed alloy compositions contain neither nickel nor palladium, which are common "whitening" elements in other white gold compositions (refer to Example 2, p. 14). The alloy compositions of the claimed invention are comprised of copper, silver, zinc and manganese and trace amounts of tin, cobalt, silicon/copper and boron/copper.

Secondly, two of the three cited references (Yan '651 and Sloboda '434) teach alloys consisting of nickel, which is the opposite purpose of the claimed invention. The alloy composition of the claimed invention does not contain nickel. Hence, the white gold compositions of the claimed invention do not contain nickel and the cited references do not anticipate the claimed invention.

Accordingly, there is no basis for a rejection of claims 1-3 and 24 under 35 U.S.C. § 103(a). The Examiner is therefore respectfully requested to withdraw these rejections.

III. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 3, 5 and 8 to 14 stand rejected under 35 U.S.C. § 103(a) unpatentable over each of Rabinkin et al. or Sloboda et al.

The teachings of Rabinkin '097 and Sloboda ' 434 are discussed above.

MPEP 2141.01(a) states that "to rely on a reference under 35 U.S.C. section 103, it must be analogous prior art ...or in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned." *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). Further, "a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

Rabinkin '097 teaches an alloy for "brazing steels, cemented carbides to steels, copper and copper alloys to steels, copper and copper and copper alloys, and composite materials to steels and copper (Abstract)." Sloboda '043 teaches a "brazing [alloy] suitable for use in the fabrication of cutting tools, for example, the brazing of a cutting tip to a shank of a rock drill (Abstract)."

The claimed invention is in the area of gold compositions for use *in casting, fabricating or soldering jewelry*. The claimed invention is not concerned with brazing two or more metals together to form a device as in the prior art. The claimed invention is concerned with making white gold compositions that do not contain nickel or palladium for use in *casting, fabricating or soldering* jewelry.

Therefore, Rabinkin '097 and Sloboda '043 alloys are for an entirely different purpose than the claimed invention. Thus, Rabinkin '097 and Sloboda '043 references are not considered analogous art, or pertinent art or reasonably pertinent art with which the claimed invention is concerned. *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). Therefore, the claimed invention is not obvious over Rabinkin '097 and/or and Sloboda '043.

Accordingly, there is no basis for a rejection of claims 1-3 and 24 under 35 U.S.C. § 103(a). The Examiner is therefore respectfully requested to withdraw these rejections.

IV. CONCLUSION

In view of the above, it is submitted that this application is now in good order for allowance, and such early action is respectfully solicited. These claims are neither anticipated by nor obvious over the references of record whether considered individually or in combination.

Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

Respectfully submitted,

Date: July 1, 2003.

Guy P. Smith Reg. No. 20,142

OPPENHEIMER WOLFF & DONNELLY LLP
233 Wilshire Boulevard, Suite 700
Santa Monica, CA 90401

ADDENDUM PAGES

CHANGES TO SPECIFICATION WITH UNDERLINING AND/OR BRACKETS

[0003] The present invention also relates generally to a white gold composition and, more particularly, to a white gold composition consisting essentially of copper, silver, zinc, and manganese and further consisting of lesser amounts of tin, cobalt, silicon/copper and boron/copper.

8-17-03